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No. 06-443

In the
Supreme Court of the United States

MARK BRUCKELMYER,

Petitioner,

v.

T.H.E. MACHINE COMPANY,

Respondent.

**On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Federal Circuit**

MOTION BY DEFENDANT GROUND HEATERS, INC. FOR LEAVE TO FILE *AMICUS CURIAE* BRIEF and BRIEF OF DEFENDANT GROUND HEATERS, INC. AS *AMICUS CURIAE* IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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MOTION FOR LEAVE TO FILE *AMICUS CURIAE* BRIEF IN OPPOSITION TO PETITION

Defendant Ground Heaters, Inc. respectfully moves under Supreme Court Rule 37.2(b) for leave to file the accompanying brief opposing Petitioner Bruckelmyer's Petition for Writ of Certiorari. Respondent T.H.E. Machine Company has consented to the filing of Ground Heaters' brief, but Bruckelmyer has refused to consent.

In the proceedings below, Ground Heaters was a party defendant in the District Court and also an appellee in the Court of Appeals. After Ground Heaters filed its appellee brief in the Court of Appeals, and shortly before oral argument, Ground Heaters and Bruckelmyer reached a settlement of the claims between them. The terms of the settlement, however, require Ground Heaters to make a substantial monetary payment to Bruckelmyer if the District Court's judgment against Bruckelmyer, which the Court of Appeals affirmed, is overturned by this Court. Accordingly, Ground Heaters has a direct and significant interest in the outcome of Bruckelmyer's Petition. It is a misstatement for Bruckelmyer to assert in his Petition that Ground Heaters "no longer has an interest in the outcome of this petition." Petition at ii.

Ground Heaters respectfully submits that its knowledge of the proceedings below and the relevant law will be

of assistance to the Court, and it requests leave to participate as *amicus curiae* in order to protect its interests.

Respectfully submitted,

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QUESTIONS PRESEN D

Grouud Heaters will address the following questions:

1. Whether this case rises to the level of importance meriting review by the Court.

2. Whether the prior art document at issue falls with the plain meaning of the text of 35 U.S.C. § 102(b).

3. Whether the judgment of the Court of Appeals also comports with the underlying purpose of 35 U.S.C. § 102(b).

4. Whether there is any merit to Petitioner Bruckelmyer's other arguments.

LIST OF PART S AND CORPORA DISCLOS STATE NT

Bruckelmyer correctly lists the parties to the proceedings below, Petition at ii, except that Bruckelmyer incorrectly states that "Ground Heaters, Inc. no longer has an interest in the outcome of this petition." *Id.*

The name of Ground Heaters' parent corporation is Wacker Corporation. No publicly held company owns 10% or more of Ground Heaters' stock.

TABLE OF CONTENTS

	Page
QUESTIONS PRESENTED	i
LIST OF PARTIES AND CORPORATE DISCLOSURE STATEMENT	ii
TABLE OF AUTHORITIES	iv
INTEREST OF THE *AMICUS CURIAE*	1
STATEMENT OF THE CASE	1
REASONS FOR DENYING THE WRIT	3
I. THIS CASE IS A FACT-SPECIFIC CASE WITH NO JURISPRUDENTIAL SIGNIFICANCE	3
II. THE CANADIAN FILE HISTORY FALLS WELL WITHIN THE ORDINARY MEANING OF "PRINTED PUBLICATION"	5
III. THE PURPOSE OF THE "PRINTED PUBLICATION" BAR IS ALSO SATISFIED	6
IV. BRUCKELMYER'S ARGUMENTS FOR CERTIORARI ARE MISPLACED	7
CONCLUSION	10

TABLE OF AUTHORITIES

Page

CASES

Amoco Production Co. v. Southern Ute Indian Tribe, 526 U.S. 865 (1999) 9

BedRoc Limited, LLC v. United States, 541 U.S. 176 (2004) 9

Constant v. AdvancedMicro-Devices, Inc., 848 F. 2d 1560 (Fed. Cir. 1988) 3

I.C.E. Corp. v. Armco Steel Corp., 250 F. Supp. 738 (S.D.N.Y. 1966) 5

In re Cronyn, 890 F. 2d 1158 (Fed. Cir. 1989) 3

In re Hall, 781 F. 2d 897 (Fed. Cir. 1986) 3, 4

In re Klopfenstein, 380 F. 3d 1345 (Fed. Cir. 2004) 3

In re Tenney, 254 F. 2d 619 (C.C.P.A. 1958) 7, 9

In re Wyer, 655 F. 2d 221 (C.C.P.A. 1981) 6, 10

K Mart Corp. v. Cartier, Inc., 486 U.S. 281 (1988) 8, 9

OTHER

Supreme Court Rule 10 3

Supreme Court Rule 37.6 2

Webster's New Twentieth Century Dictionary (1951) 5, 6

35 U.S.C. § 102(b) 3

BRIEF OF DEFE ANT GROUND HEATERS, INC. AS *AMICUS CURIAE* IN OPPOSITION TO PETITION FOR IT OF CERTIORARI[1]

INTEREST OF THE *AMICUS CURIAE*

In the proceedings below, Ground Heaters was a party defendant in the District Court and also an appellee in the Court of Appeals. After Ground Heaters filed its appellee brief in the Court of Appeals, and shortly before oral argument, Ground Heaters and Bruckelmyer reached a settlement of the claims between them. The terms of the settlement, however, require Ground Heaters to make a substantial monetary payment to Bruckelmyer if the District Court's judgment against Bruckelmyer, which the Court of Appeals affirmed, is overturned by this Court. Accordingly, Ground Heaters has a direct and significant interest in the outcome of Bruckelmyer's Petition. It is a misstatement for Bruckelmyer to assert in his Petition that Ground Heaters "no longer has an interest in the outcome of this petition." Petition at ii.

♦

STATE NT OF THE CASE

The basic facts underlying this case were correctly set forth by the Court of Appeals. Bruckelmyer Appendix at 1a-5a. In s ary, thirteen years before Bruckelmyer

[1] Pursuant to Supreme Court Rule 37.6, Ground Heaters states that no counsel other than counsel for Ground Heaters has authored this brief in whole or in part. Further, the persons who owned the shares of Ground Heaters during the proceedings below subsequently sold their stock to Wacker Corporation. The former shareholders are the only persons or entities who made a monetary contribution to the preparation or submission of this brief.

filed his patent applications, Norman Young filed a patent application in Canada, which issued as a patent in 1983. Like Bruckelmyer's patents, the Canadian patent discloses "a method of heating structures by having preheated liquid flow through flexible hoses." Bruckelmyer Appendix at 3a. Furthermore:

> To illustrate an application of the invention, the [Canadian] patent provides drawings of the claimed heating system being used to heat a beam. The patent further notes that the "system is suitable for applying heat to other objects and is not necessarily confined to use in relation to concrete placement. Other typical uses are: . . . thawing frozen ground."

Bruckelmyer Appendix at 3a.

The Canadian patent, together with the underlying application containing the invalidating documents, "were available for public inspection at the Canadian Patent Office in Hull, Quebec, more than one year before the priority date of the patents in suit." *Id.* at 4a. Upon its issuance, the Canadian patent "was indexed and cataloged according to its subject matter, and the application was also in the file of the patent office." *Id.* at 7a.

As observed by the Court of Appeals, the Canadian patent was a "roadmap" to the underlying application. *Id.* at 8a. According to the Court of Appeals, "no reasonable trier of fact could find that a person of ordinary skill in the art interested in the subject matter of the patents in suit and exercising reasonable diligence could not locate" the underlying application, including the invalidating documentation therein. *Id.* at 9a. Because the Canadian patent

was indexed and cataloged, it could serve as a "research aid" for the underlying application. *Id.* at 10a.

♦

REASONS FOR DENYING T IT

I. THIS CASE IS A FACT-SPECIFIC CASE NO JURISPRUDENTIAL SIGNIFICANCE

This case has no jurisprudential importance. The case presents none of the established reasons for certiorari in Supreme Court Rule 10. The decision of the Court of Appeals is not in conflict with a decision of another Court of Appeals. The case does not implicate any decision of a state court of last resort. The case does not involve an unsettled question of federal law. And the case does not conflict with relevant decisions of this Court. At most, this case involves alleged "erroneous factual findings or the misapplication of a properly stated rule of law," and it is thus a case in which a petition "is rarely granted." Supreme Court Rule 10. But, upon analysis, the case even lacks those types of errors.

The "printed publication" statute at issue, 35 U.S.C. § 102(b), is both rarely litigated and consistently applied at the appellate level. Since the Federal Circuit began hearing patent appeals in 1982, it has issued only four published decisions on the issue, excluding the present case. *See In re Klopfenstein*, 380 F. 3d 1345 (Fed. Cir. 2004); *In re Cronyn*, 890 F. 2d 1158 (Fed. Cir. 1989); *Constant v. AdvancedMicro-Devices, Inc.*, 848 F. 2d 1560 (Fed. Cir. 1988); *In re Hall*, 781 F. 2d 897 (Fed. Cir. 1986). In each of those cases, as well as in the present case, the Federal Circuit interpreted the term "printed publication" in a wholly consistent and uniform manner, and not even

Bruckelmyer can contend otherwise. There is simply no disagreement or divergence of views among the judges of the Federal Circuit concerning construction of the statute, much less a conflict warranting intervention by the Court.

Most significantly, the "§ 102 publication bar is legal determination based on underlying fact issues, and therefore must be approached on a case-by-case basis." *Hall, supra*, 781 F. 2d at 898. Distilled to its essence, the present case presents a highly unique set of underlying facts, circumstances that are unlikely to recur with any degree of regularity, if ever. Unlike many prior "printed publication" cases involving patent applications, the invalidating printed publication here, Young's Canadian patent application, actually issued as a Canadian patent. That patent was properly indexed and cataloged by subject matter. The patent, like Bruckelmyer's patents, "discloses a method of heating structures by having preheated liquid flow through flexible hoses." Bruckelmyer Appendix at 3a. "The [Canadian] patent further notes that the 'system is suitable for applying heat to other objects and is not necessarily confined to use in relation to concrete placement. Other typical uses are: . . . thawing frozen ground.'" *Id.* Thus, the published Canadian patent specifically refers to the precise use addressed in Bruckelmyer's patents – thawing frozen ground. And Bruckelmyer stipulated that the documents in the file history rendered his patents invalid.

Although a slim minority of the Federal Circuit judges, disagreeing with the majority's denial of Bruckelmyer's petition for rehearing, believed that these unique facts were insufficient to render the file history a "printed publication," they did so not because of a dispute about the applicable legal standard. The minority simply disagreed, as a factual matter, that an interested person would be

able to locate the material in the file history in a meaningful way. Whether this factual finding was error, as Bruckelmyer contends, or whether it was proper, as the District Court, the majority of the Court of Appeals and Ground Heaters contend, it is nothing more than a dispute concerning a unique set of facts. Nothing is broken with the system that this Court needs to fix.

The end result here is that Bruckelmyer sought in this action to enforce patents for inventions that Bruckelmyer in fact did not invent. Norman Young actually invented the inventions, and he did so some 10 years before Bruckelmyer applied for his patents. Both the District Court and the Court of Appeals refused to allow Bruckelmyer to enforce the patents. There is no need for this Court to change that result.

II. THE CANADIAN FILE HISTORY FALLS LL WITHIN ORDINARY MEANING OF "PRIN D P LICATION"

Because this case concerns statutory construction, we must consider the ordinary meaning of the statutory terms, an analysis that Bruckelmyer's Petition, for good reason, carefully avoids. The present statute was enacted in 1952. *See I.C.E. Corp. v. Armco Steel Corp.*, 250 F. Supp. 738, 741 n.13 (S.D.N.Y. 1966). At the time of enactment, the ordinary meaning of "print" was to "reproduce by any process of transfer." *Webster's New Twentieth Century Dictionary*, p. 1342 (1951) (Appendix hereto). The term also meant to "cause to be issued in print: to publish," as well as to "obtain a positive picture from (a negative) by the exposure of sensitized paper beneath a negative to actinic rays: to obtain (a positive) by the action of light transmitted through a negative." *Id.* Most certainly, the

microfiche copy of Young's patent application satisfies these definitions.

Concerning the term "publication," at the time of enactment "publication" meant the "act of publishing or offering to public notice," the "act of offering a newspaper, book or writing to the public by sale or by gratuitous distribution," or a "work printed and published." *Id.*, p. 1368. Again, the Young application most certainly satisfies this definition. When the Young patent issued, the application was offered to public notice. It was a writing offered to the public by sale (payment of the copying charges to the Canadian Patent Office). Accordingly, the Young application falls within the literal terms of the text of the statute, considering the meaning of the text at the time it was enacted, and no further analysis is necessary for denial of the Petition.[3]

III. PURPOSE OF T "PRIN D PUBLICATION" BAR IS ALSO SATISFIED

To the extent that it is necessary to consider the purpose of the statute, the ruling in this case also comports with the legislative purpose. The purpose of the "printed publication" bar is "to prevent withdrawal by an inventor, as the subject matter of a patent, of that which was already in possession of the public." *In re Wyer*, 655

[3] As the ordinary definitions of "print" and "publication" demonstrate, the two terms are interrelated and focus on public availability. To "print" means "to publish," and "publication" means a work "printed and published" or the act of "offering to public notice." Contrary to Bruckalmyer's contentions, the ordinary meaning therefore supports the court's observation in *In re Wyer*, 655 F. 2d 221, 226 (C.C.P.A. 1981), that "printed publication" should "be approached as a unitary concept."

F. 2d 221, 226 (C.C.P.A. 1981). The court in *In re Tenney*, 254 F. 2d 619 (C.C.P.A. 1958), described this purpose as follows:

> [I]n consideration for the patent grant, something must be given to the public which it did not have before. . . . If the public is already possessed of that "something," or if it is accessible to the public, there is a failure of consideration and no patent may be granted.

Id. at 624.

Here, Bruckelmyer's alleged inventions were already accessible to the public via Young's application. Any person could access the application upon request. The application was stored in a patent office for that very purpose, under a statutory scheme explicitly providing for public access once the application issued as a patent. Accordingly, the ruling below is consistent with the purpose of the statute.

IV. BRUC LMYER'S ARG NTS FOR CERTIO- SPLACED

As reflected in the decisions of the courts below, the arguments now made by Bruckelmyer in his Petition were not raised by him in the District Court, and they were not raised by him in the Court of Appeals until the last moment, when he petitioned for rehearing. And not even the two dissenting judges on the rehearing petition deemed the arguments worthy enough to address in their dissent. Assuming Bruckelmyer's arguments have not been waived, they nonetheless lack merit.

Instead of focusing on the text of the statute, Bruckelmyer raises a strawman argument designed to avoid the

ordinary meaning of the statutory terms. Bruckelmyer asserts that the court in *Wyer* (a case decided in 1981) somehow "declare[d] statutory language obsolete" and "substitute[d] judicial refashioning of a statute by reinterpretation in place of Congressional policymaking." Petition at 10. This was wrong, according to Bruckelmyer, because "even though modern technology may suggest that microfilm or other types of information should be included under the statute as invalidating prior art, this does not suggest that courts may make such choices for Congress." Petition at 11-12. According to Bruckelmyer, the court in *Wyer* "came to just the opposite conclusion" as did the court in *Tenney*. Petition at 16.

Bruckelmyer is incorrect in all respects. First of all, as a matter of statutory construction, what matters is whether the subject matter falls within the ordinary meaning of the statutory terms, regardless of so-called "modern technology." In other words, if the ordinary meaning of the text of a statute encompasses the item or thing at issue, then it matters not that the item or thing first came into existence after the statute was enacted. This principle was explained by Justice Scalia in *K Mart Corp. v. Cartier, Inc.*, 486 U.S. 281 (1988):

> A 19th-century statute criminalizing the theft of goods is not ambiguous in its application to the theft of microwave ovens simply because the legislators enacting it "were unlikely to have contemplated" those appliances; and a 1922 (or 1930) statute covering a "corporation . . . organized within, the United States" unambiguously includes a United States corporation that has licensed its trademark abroad, whether or not a United States corporation with that characteristic existed at the time. . . . [I]t seems to me the

> prerogative of each currently elected Congress to allow those laws which change has rendered nugatory to die an unobserved death if it no longer thinks their purposes worthwhile, and to allow those laws whose effects have been expanded by change to remain alive if it favors the new effects.

K Mart Corp., 486 U.S. at 323-25 (Scalia, J., concurring in part and dissenting in part). *See also id.* at 316 ("no one would doubt that '[a] 19th-century statute criminalizing the theft of goods' applies unambiguously to 'theft of microwave ovens.'" (Brennan, J., concurring in part and dissenting in part).

Thus, Bruckelmyer's reliance on cases such as *BedRoc Limited, LLC v. United States*, 541 U.S. 176 (2004), and *Amoco Production Co. v. Southern Ute Indian Tribe*, 526 U.S. 865 (1999), Petition at 10-12, is misplaced. The court in *Wyer* did not substitute its judgment for that of Congress. Nor did it rewrite the statute to account for subsequent technology. It merely rendered a holding that is perfectly consistent with the ordinary meaning of the text of the statute at the time it was enacted, as set forth above.

Finally, contrary to Bruckelmyer's assertion, there is no conflict between the holding in *Tenney* and the holding in *Wyer*, or between the holding in either of those cases and the present case. In *Tenney*, the court held that a microfilm copy of an unissued patent application, stored in a location other than a patent office and misindexed, was not a printed publication. *Tenney*, 254 F. 2d at 620-21. In *Wyer*, the court held that a properly indexed microfilm application, stored in a patent office, was a printed publication, where, among other things, copies were located in

regional offices, even though no patent had issued. *Wyer*, 655 F. 2d at 226-27. And in the present case, the Court of Appeals has held that a microfiche application, available in a patent office, was a printed publication upon issuance of a properly indexed patent, where, among other things, the issued patent explicitly refers to precisely the same use for the invention as the patents in suit. Notwithstanding Bruckelmyer's efforts to create one, there is simply no conflict between the holdings of these cases warranting review by the Court.

♦

CONCLUSION

For the foregoing reasons, the Petition for Writ of Certiorari should be denied.

October 2006

Respectfully submitted,

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App. 1

print, *v.t.*; printed, *pt.*, *pp.*; printing, *ppr.* [Shortened form of *imprint*; Fr. *empreinte*, impression, stamp, a participial form from *empreindre*, to print, imprint, from L. *imprimere*, to press.]

1. To mark by pressing; to imprint; to imprint; as, to *print* letter.

2. To press into or upon, especially so as to leave a mark; as, to *print* a kiss on one's cheek; *printing* their hoofs in the earth.

3. To take an impression of; to make a reverse copy of by pressing; as, to *print* a copperplate.

4. To produce a copy of by the use of a press; as, to *print* a newspaper.

5. To cause to be issued in print; to publish; as, the newspaper *printed* an editorial.

6. To reproduce by any process of transfer; as, to *print* a carbon copy.

7. To impress with colored patterns; to stamp figured patterns on; as, to *print* calico.

8. To obtain a positive picture from (a negative) by the exposure of sensitized paper beneath a negative to actinic rays; to obtain (a positive) by the action of light transmitted through a negative.

9. To fix deeply or imprint in the mind; to implant; to instill.

10. To form or write in imitation of printed letters; as, a child *prints* a word or a letter.

Printed goods; calicoes printed in designs.

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